

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERNST MICHAEL WINTER,
LOTHAR SCHAFFER and THORSTEN MATTHEE

Appeal No. 2003-1200
Application No. 09/319,142

ON BRIEF



Before GARRIS, WALTZ, and PAWLIKOWSKI, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the refusal of the examiner to allow claims 16-31 as amended subsequent to the final rejection.¹ The only other claim remaining in the application,

¹ The file record for this application reflects that the amendment filed February 12, 2002 (Paper No. 19) should be clerically entered. This entry should be effected upon the return of the application to the Examining Corps.

which is claim 32, stands withdrawn from further consideration by the examiner.

The subject matter on appeal relates to a gemstone comprising a plate-shaped support having a surface with a plurality of pyramid-shaped depressions, each depression having a pyramid angle formed between adjoining faces, and a vapor phase deposit layer comprising a precious stone layer applied on the plate-shaped support wherein the precious stone layer includes an underside having a plurality of pyramid-shaped projections arranged to correspondingly fit a respective one of the pyramid-shaped depressions. Further details of this appealed subject matter are set forth in representative independent claim 16 which reads as follows:

16. Gemstone comprising:

a plate-shaped support having a surface with a plurality of pyramid-shaped depressions, each of said pyramid-shaped depressions having a pyramid angle formed between adjoining faces of said at least one pyramid-shaped depression; and

a vapor phase deposit layer comprising a precious stone layer applied on said plate-shaped support in a selected orientation, said precious gemstone layer having an upper surface facing away from said plate-shaped support and an underside, said underside

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having a plurality of pyramid-shaped projections arranged to correspondingly fit a respective one of said pyramid-shaped depressions, whereby said orientation of said vapor phase deposit layer upon said plate-shaped support imparts decorative, light-reflective qualities to said gemstone.

The references set forth below are relied upon by the examiner as evidence of obviousness:

Gregory	2,521,846	Sep. 12, 1950
Lampert et al. (Lampert)	5,431,028	Jul. 11, 1995
Nassau et al. (Nassau)	5,882,786	Mar. 16, 1999
		(filed Nov. 15, 1996)

Claims 16-18, 20, 22-27 and 29-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nassau in view of Gregory, and claims 19, 21 and 28 are correspondingly rejected over these references and further in view of Lampert.²

We refer to the brief and reply brief and to the answer for a complete discussion of the opposing viewpoints expressed by the appellants and by the examiner concerning the above-noted rejections.

² On page 5 of the brief, the appellants state that appealed claims 16-31 "stand or fall together." Consistent with this statement, the only arguments advanced by the appellants against the separate rejection of dependent claims 19, 21 and 28 relate to features recited in the sole independent claim on appeal which is claim 16. Accordingly, in assessing the merits of the rejections before us, we will focus on independent claim 16 since this the only claim which has been argued with any reasonable specificity. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987); Compare In re McDaniel, 293 F.3d 1379, 1382-83, 63 USPQ2d 1462, 1464-65 (Fed. Cir. 2002).

OPINION

We will sustain these rejections for the reasons well stated by the examiner in the answer. We add the following comments for emphasis only.

It is the appellants' basic contention that the applied references contain no teaching or suggestion of the here claimed plate-shaped support having a surface with a plurality of pyramid-shaped depressions. The appellants argue that, as a consequence of this deficiency, even if the references were combined, the resulting gemstone would not correspond to the gemstone defined by the independent claim on appeal.

In our view, the recesses 35 shown in Figs. 10-12 of Gregory are encompassed by the claim 16 phrase "pyramid-shaped depressions." This is because the shape of these recesses includes the rectangular base and triangular tapering sides of a pyramid (i.e., a pyramid inverted so that the base faces upwardly as in the appellants' invention). We recognize that the "apex" of Gregory's recesses is flat rather than pointed as shown in the appellants' drawing. This fact, however, does not forestall a

determination that patentee's recesses 35 are encompassed by the "pyramid-shaped depressions" of claim 16.

In this regard, we remind the appellants that in proceedings before the Patent and Trademark Office, claims in an application are to be given their broadest reasonable interpretation consistent with the specification. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). For this reason, it is appropriate that we broadly interpret the claim phrase "pyramid-shaped depressions" to include depressions which have a shape like that shown in Figs. 10-12 of Gregory which is like the pyramid shape displayed in the appellants' drawing in all respects but for the apex being flat rather than pointed.

Indeed, because claim 16 contains no express basis for a pointed apex limitation, it would be improper to interpret the phrase "pyramid-shaped depressions" as requiring a pointed apex. That is, such an interpretation would require reading the pointed apex limitation of the appellants' specification/drawing into claim 16 to thereby narrow the scope thereof by implicitly adding a limitation which has no express basis in the claim. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

Even if claim 16 were to require a pyramid-shape which includes a pointed apex, the claim would not necessarily be patentably distinguishable over the applied prior art. This is because Gregory expressly teaches that his recesses 35 may be of any suitable shape (e.g., see the sentence bridging columns 3 and 4). This teaching in combination with the recess-shape shown in Figs. 10-12 of Gregory evinces that it would have been obvious for one with ordinary skill in the art to provide recesses having a pyramid-shape which includes a pointed apex.

In light of the foregoing and notwithstanding the appellants' contrary view, it is our determination that Gregory teaches or at least would have suggested a plate-shaped support having a surface with a plurality of pyramid-shaped depressions which include a pyramid angle as required by the claim under review. Further, we fully share the examiner's conclusion that it would have been obvious for one with ordinary skill in the art to provide the gemstone of Nassau with the previously described support having a plurality of pyramid-shaped depressions of the type taught by Gregory in order to obtain the benefits taught by

Gregory (e.g., see the paragraph bridging columns 3 and 4 and the first full paragraph in column 4).³ Upon depositing a thin coating of diamond on this support pursuant to the teachings of Nassau, the resulting gemstone would fully correspond to the gemstone defined by appealed independent claim 16.

For the reasons discussed above and in the answer, the Nassau and Gregory references evince a prima facie case of obviousness for the appealed claim 16 subject matter which the appellants have not successfully rebutted with argument or evidence in support of nonobviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We reach a corresponding determination with respect to the separate rejection based on these references and further in view of Lampert since the only arguments concerning this rejection are those advanced and found unconvincing with respect to independent

³ As a matter of completeness, we point out that an artisan would have effected this provision via a metal support in the manner taught by Gregory (which would correspond to the appellants' metal support embodiment; e.g., see lines 20-25 on specification page 3) or via a KOH-etched silicon support in the manner taught by Nassau (e.g., see lines 48-56 in column 4 and lines 7-12 in column 5) (which would correspond to the appellants' disclosed silicon support embodiment; e.g., see lines 1-8 on specification page 4); and the appellants do not argue otherwise on the record of this appeal.

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claim 16. It follows that we will sustain each of the examiner's
§ 103 rejections before us in this appeal.

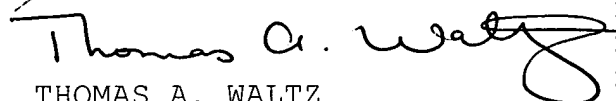
The decision of the examiner is affirmed.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED

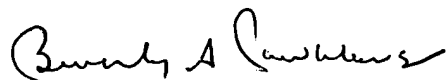


BRADLEY R. GARRIS)
Administrative Patent Judge)



THOMAS A. WALTZ)
Administrative Patent Judge)

BOARD OF PATENT
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BEVERLY A. PAWLIKOWSKI)
Administrative Patent Judge)

brg/vsh

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ROBERT W. BECKER & ASSOCIATES
707 HIGHWAY 66 EAST
SUITE B
TIJERAS, NM 87059